

REMARKS

By the above amendment, claims 6, 24 and 28 have been canceled without prejudice or disclaimer of the subject matter thereof, independent claims 1, 9, 16, and 21 have been amended in a manner which is considered to overcome at least the rejection of claim 1 under 35 USC 112, second paragraph, with the dependent claims being amended in accordance with the language of the parent claims. Additionally, a new dependent claim 29 has been added which depends from claim 1 and further defines the features of the present invention.

Turning to claim 1, in view of the points raised by the Examiner, claim 1 has been amended to clarify the features of the present invention, with the other independent claims be amended in a similar manner, noting that the present invention is directed to an automated teller machine (ATM) which receives and pays out paper money of different denominations, such that, as now recited in each of the independent claims of this application, the present invention is directed to "an apparatus for handling sheets containing information thereon" (emphasis added), and includes structure as defined with an information reader arranged along the transfer direction of the selected sheet so as to face a surface of the selected sheet which is being transferred and delimiting an information reading range within which the information contained on the selected sheet is readable by the information reader, which information reading range includes an information reading point at which the information contained on the selected sheet is read from the selected sheet by the information reader, as illustrated in Fig. 4 of the drawings of this

application and as described in the corresponding description of the specification. That is, as described, in which the information reader obtains optical or magnetic information of the paper money 21. Thus, looking to Fig. 4 and corresponding description of the specification, a movable sheet transfer member, as represented by the roller 24a, having a transfer surface which contacts one of the sheets of paper money 21 containing the information thereon so as to transfer the selected sheet alone a transfer direction, and a sheet supporting surface area S is disposed so as to be contactable with the selected sheet which is being transferred, as illustrated. As also illustrated, the information reader 31, for example, is arranged along the transfer direction of the selected sheet so as to face a surface of the selected sheet which is being transferred, and delimiting an information reading range, as illustrated, within which the information contained on the selected sheet is readable by the information reader, which information reading range includes an information reading point, as illustrated, at which the information contained on the selected sheet is read from the selected sheet by the information reader. Moreover, as illustrated in Fig. 4 and described in the specification, a tangential line (g), as illustrated, at a boundary point of the transfer surface of the sheet transfer member from which the selected sheet starts to separate from the transfer surface of the transfer member, extends in a side area of an imaginary straight line, as illustrated, passing through the boundary point, as illustrated and the information reading point so as to intersect the sheet supporting surface (S) at a position between the boundary point and a furthest extent of the information reading range from the boundary point, as recited in

claim 1. In accordance with the present invention, as recited in claim 1, the boundary point corresponds to a point at which the sheet transfer member contacts the selected sheet, and the boundary point and the sheet supporting surface are spaced from each other in a direction perpendicular to the imaginary straight line, and the selected sheet is pressed against the sheet supporting area at a position between the boundary point and the information reading range, as clearly illustrated in Fig. 4 of the drawings of this application. Thus, applicants submit that claim 1, as amended, should be considered to be in compliance with 35 USC 112, noting that the other independent claims of this application have been amended in a similar manner such that all claims present in this application should be considered to be in compliance with 35 USC 112, second paragraph, with new dependent claim 29 reciting the feature that the apparatus forms a part of an automated teller machine and the sheets containing information thereon are paper money. Applicants submit that the features as recited in independent and dependent claims of this application are not disclosed or taught in the cited art, as will become clear from the following discussion.

As to the rejection of claims 1, 3, 6 - 9, 11, 12, 15, 17 - 20 and 25 - 27 under 35 USC 102(b) as being anticipated by Kawasaki (US 7,296,795); the rejection of claim 10 under 35 USC 103(a) as being unpatentable over Kawasaki in view of Henry (US 4,567,349); the rejection of claims 14, 16 and 21 under 35 USC 103(a) as being unpatentable over Kawasaki in view of Henry and further in view of Kako (US 2002/0060421 A1); and the rejection of claims 24 and 28 under 35 USC 103(a) as being unpatentable over Kawasaki

in view of Koch (US 5,809,885); such rejections are traversed insofar as they are applicable to the present claims, as amended, and reconsideration and withdrawal of the rejections are respectfully requested.

As to the requirements to support a rejection under 35 USC §102, reference is made to the decision of In re Robertson, 49 USPQ 2d 1949 (Fed. Cir. 1999), wherein the court pointed out that anticipation under 35 USC §102 requires that each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. As noted by the court, if the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if the element is "inherent" in its disclosure. To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Moreover, the court pointed out that inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

Irrespective of the Examiner's interpretation of Kawasaki, which is a mischaracterization of the disclosure of Kawasaki, as will be discussed below, applicants note that Kawasaki is not directed to an automated teller machine (ATM), for handling sheets containing information thereon, in the form of paper money, as disclosed in the present application, but rather Kawasaki is directed to a sheet handling apparatus of a recording media used in a copier, or the like, and is directed to detecting double feed of sheet materials, as

described at column 1, lines 22 - 28 of the specification. Thus, referring to the Examiner's description in the paragraph bridging pages 6 and 7 of the Office Action, of an information reader, as represented by member 3 in Fig. 17 of Kawasaki, as described in column 8, lines 13 - 28 of Kawasaki, "The external force detection means may be provided on the side of the external force application means. Fig. 17 shows the former example (an example in which the external force detection means 3 is placed in the position opposite the external force application means 2 with the sheet material P therebetween)". (emphasis added). Further, as described in columns 7 and 8 of Kawasaki, the force application means may be provided with a member that vibrates on receiving a force, and when a piezoelectric element is used, the external force is detected as a voltage signal in which absorption of the applied external force by the sheet material can be efficiently detected, so that a double feeding of the sheet material can be determined. Thus, the sheet material of Kawasaki does not contain information thereon, as recited in the independent claims of this application, and the external force detector 3 is not "an information reader", as recited in independent and dependent claims of this application. As is apparent from Kawasaki, the external force detector 3 does not delimit an information reading range within which the information contained on the selected sheet is readable by the information reader, which information reading range includes an information reading point at which the information contained on the selected sheet is read from the selected sheet by the information reader, as recited in the independent claims of this application. Thus, irrespective of the contentions by the Examiner,

independent claim 1 and the other independent and dependent claims of this application recite features of the information reader which is not disclosed by Kawasaki in the sense of 35 USC 102 or rendered obvious in the sense of 35 USC 103. Accordingly, applicants submit that all claims patentably distinguish over Kawasaki with respect to this feature of the information reader, alone.

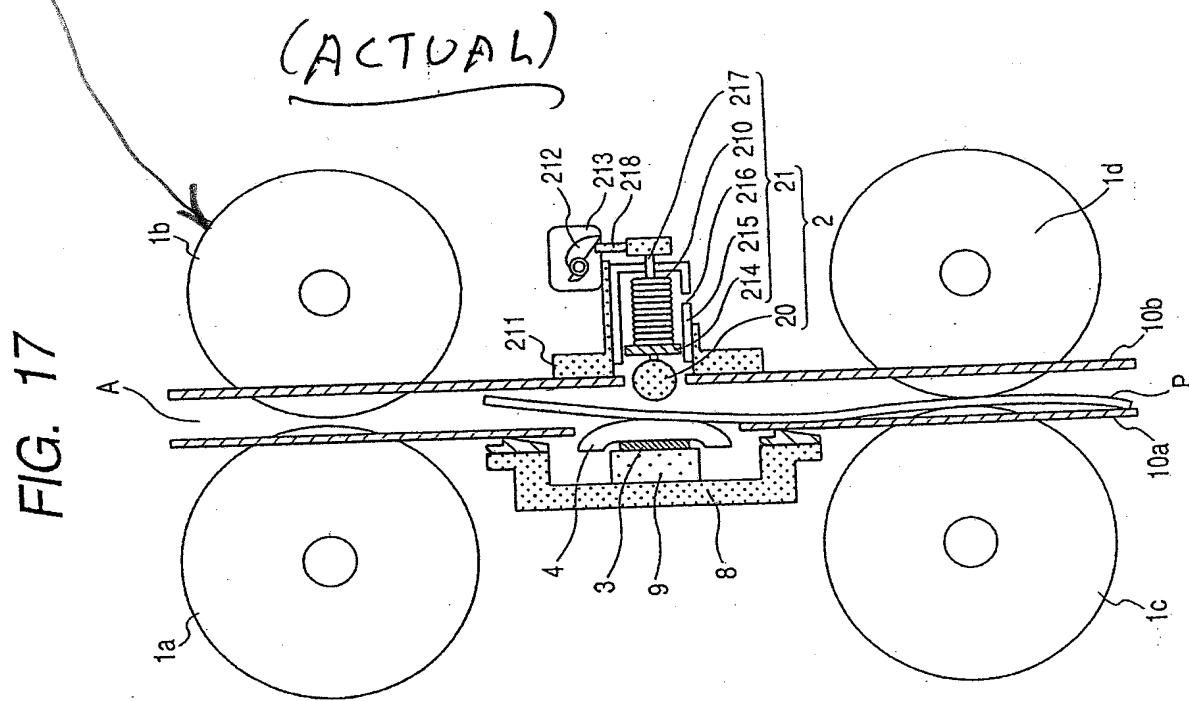
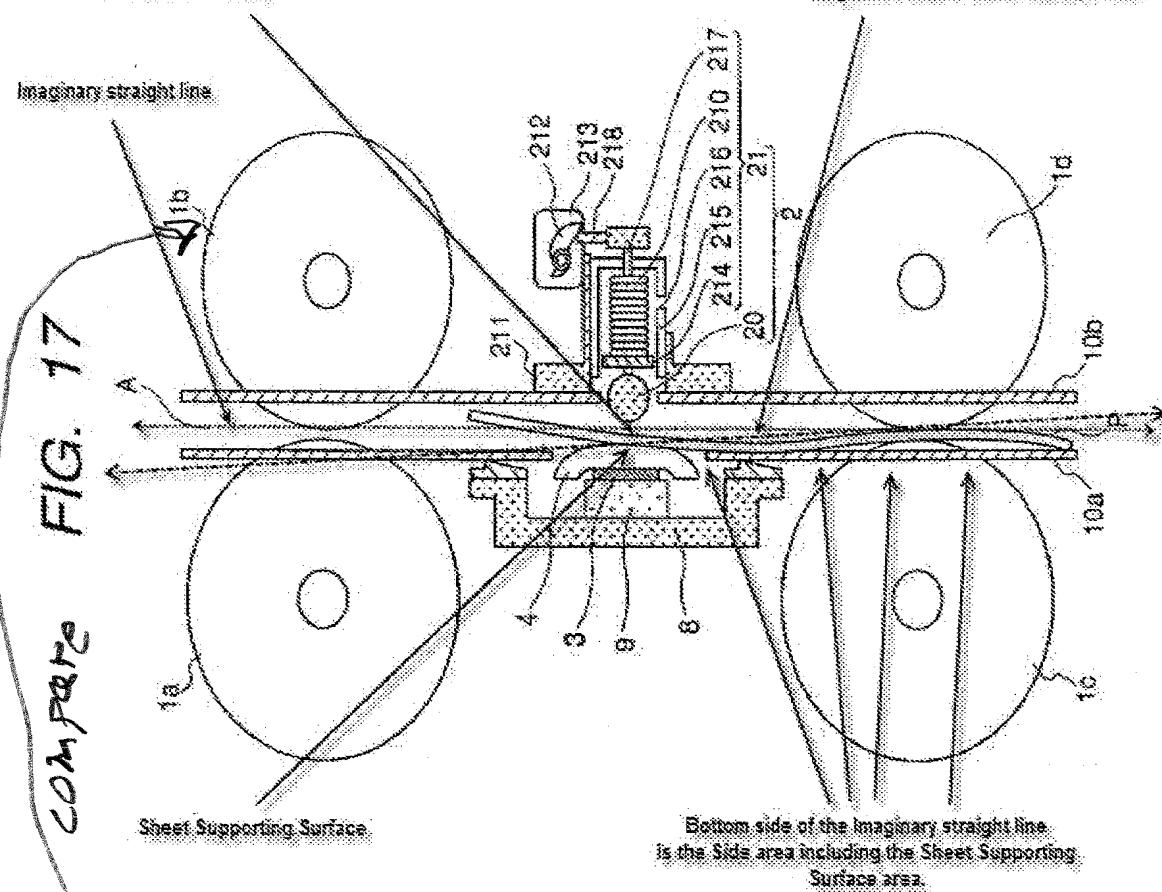
Furthermore, with regard to other features of independent claim 1 and other independent claims of this application concerning boundary points tangential lines or imaginary straight lines as defined, Kawasaki provides no disclosure or teaching of such features. That is, while the Examiner at page 16 of the Office Action reconfigures and annotates Fig. 17 of Kawasaki, such reconfiguration and annotation is based upon speculation of the Examiner without any disclosure or teaching in the specification of Kawasaki, and is a distortion of Fig. 17 of Kawasaki, as apparent from the comparison of the actual Fig. 17 of Kawasaki, presented below the Examiner's reconfigured and annotated version, looking for example to the configuration of the rollers 1a - 1d in the Examiner's reconfigured annotated version, in relation to the actual version. Also, while the Examiner adds various features, such as imaginary straight line, such addition is based upon speculation of the Examiner, and not based upon the disclosure of Kawasaki, which is improper. See In re Robertson, supra. Thus, irrespective of the annotations provided by the Examiner, applicants submit that there is no disclosure or teaching in Kawasaki of the structural features as recited in claim 1 and the other independent claims of this application in the sense of 35 USC 102 or 35 USC

103, and all claims recite features which patentably distinguish over Kawasaki, and should be considered allowable thereover.

(Examiner's Reconfigured and Annotated)

Information Reading Point

Tangential Line of the Boundary Point



With respect to the addition of the secondary references to Kawasaki in order to attempt to meet claim limitations, applicants submit that only Kako relates to an automated teller machine and fails to provide structure as recited in the independent and dependent claims of this application which would overcome the deficiencies Kawasaki, as pointed out above. Thus, applicants submit that Kawasaki, taken alone or in combination with the other cited art, fails to provide the recited features of the independent and dependent claims of this application, and all claims should be considered allowable thereover.

With respect to the dependent claims, applicants submit that the dependent claims, when considered in conjunction with the parent claims, recite further features of the present invention such as claim 25 which recites the feature of an offset between the drive roller and the driven roller and claim 29 which recites the feature that the apparatus forms part of an automated teller machine and the sheets containing information thereof are paper money which information thereon is read by the information reader. Thus, the dependent claims recite further features which patentably distinguish over the cited art and all claims should be considered allowable.

In view of the above amendments and remarks, applicants submit that all claims present in this application should be considered to be in compliance with 35 USC 112, and all claims should be considered allowable over the cited art. Accordingly, issuance of an action of favorable nature is courteously solicited.

To the extent necessary, applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in

connection with the filing of this paper, including extension of time fees, to the deposit account of Antonelli, Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (Case: 500.43486X00), and please credit any excess fees to such deposit account.

Respectfully submitted,

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